

REMARKS

In response to all of the Examiner's objections and rejections, submitted herewith is a Declaration of Roland Hölzl (hereafter, the "Declaration"), the inventor of the U.S. Patent No. 5,026,998 which the Examiner has relied upon in her rejections under § 103. This Declaration provides factual evidence that directly refutes the assumptions and conclusions expressed by the Examiner and explains why the invention is not obvious in view of his patent and the acknowledged commercially available optoelectronic sensors as well as why one of ordinary skill in the art would both be able to make and use the claimed invention based on his/her knowledge and the original disclosure of the present application and would recognize that the present inventor was in possession of the invention recited in the claims. On the basis of this Declaration and the following remarks, reconsideration and withdrawal of the objections and rejections contained in the Examiner's November, 2006, Office Action are in order and are now requested.

The Examiner has objected to the preceding amendment of August 15, 2006, as containing new matter with regard the reference to a "known location" with respect to the light source means, the first optoelectronic sensor and the manner in which results are obtained and has rejected the claims on the same basis under 35 USC § 112, first paragraph with respect to both the written description requirement and the enablement requirement.

Since the Examiner's positions as stated in the Office Action do not appear to reflect the proper standard for determining what constitutes new matter and compliance with the enablement and written description requirements, the following is noted.

The new matter objection under 35 USC § 132 is inappropriate since it is based solely on language added to the claims, no amendments having been made to the abstract, specification, or drawings. As pointed out in the MPEP § 706.03(o), "35 U.S.C. 132 >(a)< should be employed as a basis for objection to amendments to the abstract, specification, or drawings attempting to add new disclosure to that originally disclosed on filing", but if a claim contains subject matter that is not found in the original disclosure, it "is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph" as has also been done by the Examiner, and is addressed separately below. Since a new matter objection under 35 USC § 132 cannot properly be made based solely on language added to a claim, this objection must be withdrawn, and such action is requested.

As mentioned above, the claims have been rejected under 35 U.S.C. 112, first paragraph for failing to meet the written description requirement. This rejection is traversed for the following reasons.

As noted by the Examiner, To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. It has been held that there is no *in haec verba* requirement for literal use of the claim language, and that it is sufficient that newly added claim limitations be supported in the specification through express, implicit, or inherent disclosure. Furthermore, as stated in MPEP § 2163II(b):

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See *Wertheim*, 541 F.2d at 263, 191 USPQ at 97 ("[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.").

The MPEP also states in Section 2163III(a) that:

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion. These findings should:

(A) Identify the claim limitation at issue; and

(B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

In the present case, the Examiner has merely stated her conclusion that the specification does not describe the claimed invention in sufficient detail that one skilled in the

art can reasonably conclude that the inventor had possession of the claimed invention without any explanation of the type required as to why that is the case. On the other hand, section 4 of the Declaration contains, in the first paragraph of that section, a statement by one of ordinary skill in that art that the specification “reflects the fact that The Inventor was in possession of the invention recited in The Claims,” and then, in the following paragraphs of that section explains in detail why. Thus, in the absence of facts, not opinion, which rebut the facts established by the declarant, the rejection based upon the written description requirement must be withdrawn.

The claims were also rejected under 35 U.S.C. 112, first paragraph as being based on a non-enabling disclosure. However, the same section 4 of the Declaration clearly establishes that one of ordinary skill in the art would know how to make and use the invention, both with respect to the known location recitations and how to measure and evaluate the relative position of two elements with respect to each other. As pointed out in MPEP § 2164.05, a “declaration or affidavit is, itself, evidence that must be considered The examiner should **never** make the determination based on personal opinion” (emphasis in original). Still further, MPEP § 21604.08 points out that the Federal Circuit has held that “[a]ll that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear a “reasonable correlation” to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).” Here, the declarant has explained why/how one of ordinary skill in that art would be able to practice the claimed invention given the disclosure of the Lysen patent (USP 6,337,742), the fact that “the primary difference between the device described in the Hermann Application and that described in the Lysen Patent is that the beam splitter 22 of the Lysen Patent is eliminated and the reflectivity of sensor 110 of the Hermann Application is utilized instead,” and that the reference in paragraph [0026] of the specification (which presumably the Examiner is not asserting to be invalid as based on a non-enabling disclosure) to the fact that the invent “is ‘especially suited’ for use in the position detection system of “German Patent Application DE 19733919 and U.S. Patent 6,049,378” is a clear disclosure that techniques for measuring or evaluating the relative position of two elements with respect to each other of the Lysen Patent apply to the invention of the Hermann Application.”

Therefore, also in this case, in the absence of facts, not opinion, which rebut the facts established by the declarant, the rejection based upon the enablement requirement also must be withdrawn and act to that effect is requested.

The claims have also been objected to as being confusing and indefinite, however, paragraph 4 of the Declaration attests to the fact that one of ordinary skill in the art would not find the claims to be confusing or indefinite and explains why such a person would understand what was meant by the language of the claims. Thus, since such facts rebut the Examiner's conclusion, this objection must be withdrawn and such action is hereby requested.

Turning now to the Examiner's rejection of claims 1, 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over the Holzl '998 patent when viewed in conjunction with applicant's admitted prior art, in addition to the prior declaration evidence supporting applicant's view that this repeated rejection is totally inappropriate, any vitality that the Examiner's rejection may have had is completely eliminated by the evidence presented in the appended Declaration which presents the views of the very inventor whose patent the Examiner has relied upon to support her position that the claimed invention is obvious. The Examiner simply cannot continue to rely upon her opinion as to what one of ordinary skill in the art would have found to be obvious when the patentee of the patent she is relying upon presents declaration evidence that clearly and unequivocally establishes that the invention would not have been obvious from anything taught that he taught when considered in combination with that which was known to those of ordinary skill in the art. In this regard, the Examiner's attention is directed to paragraphs 3 & 5 of the Declaration, which states in part:

... at that the time of that the Hermann Application was filed, I and others in the field considered the reflectivity of the sensors to be a problem which had to be minimized or eliminated, for example, by blackening internal surfaces to avoid stray reflections, etc. and I know of no one that considered the reflectivity of the optoelectronic sensors to be a usable feature prior to that discovery by Mr. Michael Hermann, the inventor of the Hermann Application (hereafter, "The Inventor").

... there is simply no basis for the Examiner's conclusion that it would have been obvious to use the reflective properties of the commercially available optoelectronic sensors in the manner taught by the Hermann Patent Application and in the manner set forth in The Claims. Likewise, while the

operation principles of the device of the Hermann Patent Application are the same as in the Lysen Patent (not the device of My Patent which does and cannot use a a housing in which first and second two-dimensionally readable optoelectronic sensors are fixed), there is simply no factual basis for the Examiner's conclusion that it would be "an obvious matter of design choice" to make the **structural** changes necessary to go from the device of the Lysen Patent to that of the Hermann Patent Application while retaining the same basic function, let alone to do so going from the very different method and apparatus of My Patent to that of the Hermann Application.

Not only is the Examiner's conclusions of obviousness erroneous, but they have been arrived at using an improper "obvious matter of design choice" standard of obviousness that is contrary to the law as stated by both the Board of Appeals in the case of Ex Parte Gerlach and Werner, 212 USPQ 471, (1980) which states that:

There is nothing in the statutes or the case law which makes 'that which is within the capabilities of one skilled in the art' synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change [the structure of the references to that which was claimed].

and the Federal Circuit which has stated that the mere fact that a modification could be made does not make it obvious absent a teaching of desirability; see, In re Deminski, 230 USPQ 313 (Fed. Cir. 1986); In re Gordon, 221 USPQ 1125 (1984). In the present case, not only has the Examiner failed to provide the requisite reason or motivation for what she contends to be obvious, but she also does not even attempt to determine what changes would be needed since more than a mere change of one sensor for another is required. Thus, the Examiner has not made the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 48 (Supreme Court 1966), which include providing reasons why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention based upon some teaching, suggestion or inference in the prior art, Uniroyal, Inc. v. Rudkin-Wiley, 5 USPQ2d 1434 (Fed. Cir. 1988). The statement that something is an "obvious design choice" is a mere conclusion for which some factual evidence in the prior art must be established, something the Examiner has wholly failed to do and something that the Declaration emphatically refutes.

For example, the Examiner has failed to indicated where it is taught or suggested by the AAPA (or Holzl) that the reflective capabilities of the surface of a first optoelectronic

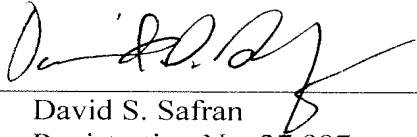
sensor can be utilized in a two-sensor position determination system when the declarant states that such was unknown at the time that the present invention was made. The AAPA cannot be relied upon for such evidence since it is merely a statement that the present applicant found a know sensor which will serve the needs of the claimed invention, not that this fact was known prior to his discovery. It is incumbent upon the Examiner, in the face of the Declaration, to provide some evidence which refutes the Declaration statement and demonstrates that someone other than this applicant recognized that the reflectance possessed by the known optoelectronic sensors was anything other than a detriment and could be used to provide accurate position determinations in combination with a second optoelectronic sensor in the manner of the present invention. In this regard, the previously submitted evidence of the results of a search of the USPTO patent database that revealed more than 1000 patents which disclose such anti-reflectance coatings for optoelectronic sensors clearly demonstrates that one of ordinary skill in the art considered the reflective characteristics of the surface of an optoelectronic sensor to an undesirable feature (as evidenced by the common use of anti-reflection coatings on such sensors and corroborating that which is attested to in the Declaration).

On the other hand, the Examiner has made no attempt to refute the evidence provided which also included the fact that the devices of the referenced U.S. Patents 6,337,742 and 6,476,914 (which are more recent than that of the Hölz patent relied upon by the Examiner) found it necessary to use mirrors and prism instead of the reflective capacity of the sensors, further indicating that the potential usefulness of the reflective properties of know sensors could be used and need not be counteracted. In this regard, it is pointed out that the Federal Circuit has held that proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (1986).

Therefore, in light of the deficiencies in the Examiner's assessment commented upon above, even if an initial *prima facie* case of obviousness had been established by the combination of the teachings of Holzl and AAPA, it has been overwhelmingly rebutted so that the burden of proof has shifted back to the Examiner to provide factual evidence, not her own opinions, which would support a conclusion of obviousness despite the evidence submitted by applicant, something that has not even been attempted up to date. Consequently, the rejection of claims 1, 3 and 4, under § 103(a), is improper and should now be withdrawn.

The present application should now be in condition for allowance and action to that effect is requested. However, should the Examiner find some issue to remain unresolved, or should any new issue arise, which could be eliminated through discussions with the Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited. Likewise, if the Examiner has some proposal for revisions to the claims that would facilitate allowance of this application, she is invited to present same to applicant.

Respectfully submitted,

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